REMARKS

The following remarks are submitted to address the rejections in the Office Action mailed March 26, 2004. Filed herewith is a request for a two month extension of time.

Claims 1-3, 14-22 and 122-130 are pending in the application. Applicants have elected claims 14-22 in response to the Examiner's restriction requirement and claims 4-13 and 23-121 have been withdrawn from the application. Claims 1-3 are currently amended and claims 122-130 are newly added by the foregoing amendment. Support for the claim amendments and new claims is found throughout the specification. Claims 1-3 and 14-22 are rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement. Claims 1-3 are rejected under 35 U.S.C. § 102(e) as being anticipated United States Patent No. 6,304,869 to Moore et al. (hereinafter "US '869").

Claims 1-3 and 14-22 and 35 U.S.C. § 112 Paragraph 1

The rejection of claims 1-3 and 14-22 as failing to comply with the enablement requirement pursuant to 35 U.S.C. § 112, paragraph 1 is respectfully traversed. The test in determining whether a patent document satisfies the enablement requirement of § 112, paragraph 1 is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.[1]

The Examiner states that the model used to predict the standard adhesive properties for the component blends is not disclosed and one of ordinary skill in the art would not know how to predict the standard adhesive properties for component blends having different proportions than those in Figure 7G.[2] Applicants respectfully assert that the model for calculating values for the standard adhesive properties of component blends is disclosed thereby allowing one of ordinary skill in the art, without undue experimentation, to determine the standard adhesive properties of component blends that display proportions divergent from those in Figure 7G.

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[1] In re Wands 858 F.2d 731, 737, 8 USPQ 2d 1400, 1404 (Fed. Cir. 1988).
[2] Office Action Mailed March 26, 2004

The specification and figures, in an example, disclose that a user is required to enter individual percentages of *Eastotac H-100R resin*, natural rubber, and paraffin oil that collectively sum to 99.5% of the composition since the remaining 0.5% of the component blend composition remains fixed as an antioxidant.[3] Once values for the three components are entered, the system proceeds with calculating values for six standard adhesive properties. The calculations for the standard adhesive properties are based on the results of a modeling experiment in which 13 different blends consisting of various percentages of the three component ingredients were analyzed.[4] The analysis of the 13 different blends produced data points from which a trilinear analysis for each standard adhesive property is constructed. Figures 7E and 7G illustrate graphical representations of trilinear analyses for several standard adhesive properties.

The percentages for the three variable components entered by a user compose a data point that is compared with the data points used to construct the trilinear analyses for each standard adhesive property. A correlation between the user entered data point and the data points used to construct the analysis is drawn. This resulting correlation delineates the value for the standard adhesive property being determined. With the values for the 13 different blends provided in Figure 7G, one of ordinary skill in the art would understand how to construct a system and method for predicting the standard adhesive properties of a component blend based on a trilinear analysis without undue experimentation.

Additionally, claim 22 is directed to a computer-readable medium for predicting the standard adhesive properties of a component blend. With the model for calculating the standard adhesive properties of a component blend sufficiently disclosed in the specification, one of ordinary skill in the art would understand how to translate this model into a computer readable medium comprising computer code for receiving, processing, and outputting data without undue experimentation.

The Examiner additionally rejects claims 1-3 and 14-22 stating that the specification provides no guidance for predicting the standard adhesive properties of

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[3] Specification, page 24.
[4] Specification, page 22.

other types of adhesives or pressure sensitive adhesives having component blends other than those consisting of *Eastotac H-100R* resin, natural rubber, and paraffin oil.

Applicants respectfully assert that the modeling experiment in conjunction with the trilinear analysis described in the specification for predicting the standard adhesive properties of a pressure sensitive adhesive comprising *Eastotac H-100R* resin, natural rubber, and paraffin oil can be extrapolated without undue experimentation to predict the standard adhesive properties of component blends comprising various other ingredients. One of ordinary skill in the art would recognize that the principles governing the modeling experiment for producing a trilinear analysis in the present application are independent of the component blend composition of a pressure sensitive adhesive, thereby allowing a uniform application of the modeling experiment to various component blends for calculating their respective adhesive properties. For example, one of ordinary skill in the art can apply the modeling experiment and trilinear analysis to a pressure sensitive adhesive having a component blend comprising a 100C tackifier, low melt tackifier, natural rubber, paraffin oil, and phenol oxidant to calculate the standard adhesive properties of the component blend in the same manner as the modeling experiment was applied to the pressure sensitive adhesive having a component blend comprising *Eastotac H-100R* resin, natural rubber, and paraffin oil. As a result, Applicants respectfully assert that the specification provides sufficient guidance and disclosure for predicting the standard adhesive properties of pressure sensitive adhesives having any component blend composition.

The Examiner further states that there is no guidance or disclosure for predicting the standard adhesive properties for a component blend where the total [of the three variable components] is not 99.5%. One of ordinary skill in the art would understand that the percentages of individual ingredients of a component blend sum to 100%. The specification states that one illustrative component blend consists of *Eastotac H-100R* resin, natural rubber, paraffin oil, and an antioxidant. With the percentage of the antioxidant fixed at 0.5%, the percentages of the remaining three ingredients are required to sum to 99.5% in order to have a complete entry for calculation of the standard adhesive properties of the component blend. Figure 7C displays that the percentages of *Eastotac H-100R* resin, natural rubber, and paraffin oil must total to 99.5%. One of

ordinary skill in the art would recognize that a user entry wherein the percentages of the three variable ingredients do not sum to 99.5% is incompatible with the model disclosed for predicting the standard adhesive properties for a component blend and renders the claimed systems and methods inoperable. As a result, requiring a disclosure for predicting the standard adhesive properties of a component blend where the total of the three variable ingredients does not equal 99.5% is placing an interpretation on the claims that is inconsistent with the scope of the specification and, therefore, cannot serve as a valid basis for a rejection under § 112 paragraph 1.

The Examiner additionally rejects claims 1-3, 14, 16, 18, 19, 20, and 22 stating that the claims do not specify what input is. According to the specification, the systems and methods of the present invention require the entry of percentage values for the individual ingredients comprising a component blend. Other types of user entry are incompatible with the claimed systems and methods and renders the model utilized to calculate the standard adhesive properties inoperable. A user entry such as "Post-it-Notes," for example, is not suitable for processing by the systems and methods of the present invention as disclosed in the specification. As a result, requiring a disclosure for predicting the standard adhesive properties of a component blend where the user input is not a component formulation comprising percentages of individual ingredients is placing an interpretation on the claims that is inconsistent with the scope of the specification and, therefore, cannot serve as a valid basis for a rejection under § 112 paragraph 1.

The Examiner also rejects claims 1-3, 14-15 and 17-22 as failing to specify what particular standard adhesive properties of the component blend are to be calculated and output. In particular, the Examiner states that it is unknown how a standard adhesive property such as adhesion to a particular substrate or viscosity would be predicted based on the teachings of the specification.

As described in the specification and figures, each standard adhesive property of a component blend is predicted on the basis of a modeling experiment in conjunction with a trilinear analysis.[5] The principles governing the modeling experiment and corresponding trilinear analysis are independent of the standard adhesive property being calculated, which allows application of this model in the prediction of a wide variety of

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[5] Page 22; Figures 7E and 7G

standard adhesive properties. The standard adhesive property of 180 Degree Peel, for example, is predicted according to the same model as the standard adhesive property PolyKen Tack. Figure 7G is exemplary of this fact and displays the modeling experiments and trilinear analyses of the standard adhesive properties of 180 Degree Peel and Polyken Tack.

The generality of the modeling experiment in conjunction with a trilinear analysis permits its utilization in predicting a standard adhesive property such as adhesion to a particular substrate (for example, glass or wood) or viscosity. Therefore, Applicants respectfully assert that the specification provides sufficient disclosure to enable one of ordinary skill in the art to predict standard adhesive properties of a component blend outside those specifically described in the application.

In view of the foregoing discussion, Applicants respectfully assert that claims 1-3 and 14-22 are enabled pursuant to 35 U.S.C. § 112 paragraph 1 thereby allowing one of ordinary skill in the art to practice the claimed invention without undue experimentation and respectfully request that the Examiner withdraw the present rejection of these claims.

Claims 1-3 and 35 U.S.C. § 102(e)

The rejection of claims 1-3 under 35 U.S.C. § 102(e) as anticipated by Moore et al., US Patent No. 6,304,869 ("US '869") is respectfully traversed.

US '869 relates to a chemical structure search system. software modeling of chemical structures. In contrast, claims 1-3 are directed to a system, method and computer readable media for assisting a user in the selection of a product, function or service that at least partially satisfies a need of the user. Examples of potential needs of a user are set forth in the detailed description and examples of the present specification.

US '869 does not disclose or suggest receiving input relating to a need, processing the input and generating output relating to those needs. As such, US '869 cannot anticipate the present claims and the Examiner is respectfully requested to withdraw the rejection.
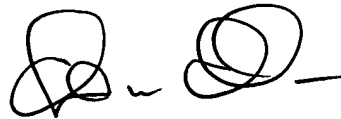
New Claims

New claims 122-130 are presented to more particularly claim particular embodiments of the present invention. The cited art fails to disclose or suggest the subject matter of claims 122-130 and therefore allowance of these claims is respectfully solicited.

Conclusion

The present application has been placed in condition for allowance. The Examiner is respectfully invited to contact the undersigned to discuss any matter relating to the application.

Respectfully submitted.

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